

ATTORNEY DOCKET NO.
004578.1073

PATENT APPLICATION
09/660,733

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REMARKS

Applicants acknowledge receipt of the Advisory Action mailed on October 7, 2002. The Advisory Action raises issues which are discussed separately below.

Refusal to Enter Amendment

Paragraphs 2 and 7 of the Advisory Action set forth a refusal to enter Applicants' Amendment filed September 20, 2002. The refusal to enter this Amendment is respectfully traversed, for the following reasons.

First, in paragraph 2(c), the Advisory Action asserts that the Amendment does not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. This assertion is respectfully traversed. Paragraph 3 of the Advisory Action states that the Amendment completely overcomes the rejection of the claims under the second paragraph of 35 U.S.C. §112. It is respectfully submitted that the complete elimination of the relatively complex issues involved in the §112 rejection would unquestionably have the benefit of "materially reducing or simplifying the issues for appeal". To the extent the Advisory Action states that the Amendment completely eliminates the §112 rejection while also stating that the Amendment would not materially reduce/simplify the issues for appeal, the Advisory Action is not consistent with itself. It is respectfully submitted that entry of the Amendment will place the application in significantly better form for appeal by completely eliminating one complex issue, and Applicants believe that this consideration alone justifies entry of the Amendment.

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A second reason for the refusal to enter the Amendment is set forth in paragraph 2(a) of the Advisory Action, where the Examiner asserts that the proposed changes to the claims raise new issues which would require further consideration and/or search. This assertion is respectfully traversed. As discussed from line 22 on page 8 through line 16 on page 9 of the Amendment, and as also discussed in the Examiner's Interview Summary mailed on September 23, 2002, the changes to the claims are fundamentally changes proposed by the Examiner, and not by Applicants. Applicants agreed to make a variety of changes proposed by the Examiner, and then incurred the effort and expense of submitting an Amendment to implement these changes, because of Applicants' understanding that the Examiner had agreed she would in fact enter an Amendment implementing these changes. During the telephone interview, the undersigned specifically and intentionally had the Examiner confirm that her proposed changes to the claims would not be viewed as altering the scope of any claim, in order to ensure that if Applicants implemented the Examiner's proposed changes, there would not be any assertion that the changes raise new issues. The agreement on this point is reflected in lines 8-10 on page 9 of the Amendment.

Since it was agreed that the changes do not alter the scope of the claims, it is not possible for there to be any new issue on the merits which would require further consideration and/or search. To the extent the Advisory Action now asserts that the changes would raise new issues, the Advisory Action is not consistent with the agreement reached during the telephone interview. It is respectfully submitted that the claim changes made by the Amendment do not raise any new issues which would require further consideration and/or search, and that it is therefore not proper for the

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Advisory Action to refuse to enter the Amendment on the asserted theory that new issues have been raised.

For the reasons discussed above, it is respectfully submitted that there is no valid basis for the refusal to enter the Amendment filed September 20, 2002. Accordingly, entry of this Amendment is respectfully requested.

Incorrect Statement in Advisory Action

In paragraph 5, the Advisory Action states that Applicants' arguments do not place the application in condition for allowance. More specifically, the Advisory Action asserts that Applicants have failed to present "evidence" to support an argument that prior art references relied on by the Examiner each fail to disclose a particular element recited in Applicants' claims. This assertion is respectfully traversed, because it is the Examiner, rather than Applicants, who has the burden of producing "evidence" sufficient to establish a prima facie case of anticipation under 35 U.S.C. §102.

In particular, §102 provides that "A person shall be entitled to a patent unless" the Patent Office (i.e. the Examiner) produces evidence in the form of a prior art document which shows each and every claimed element. In the present application, the Examiner has relied on references that each fail to show a particular element which is recited in Applicants' claims. To the extent this element is missing from each of these references, the Examiner has failed to meet the burden under §102 of presenting evidence which shows this feature.

In the present case, the Examiner has made vague assertions that the feature in question is disclosed somewhere within selected references, but has not identified any

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specific portion of any cited reference which supposedly teaches this specific feature (nor would it be possible to do so in view of the fact that the cited references all appear to lack any disclosure of this particular feature). Thus, the Examiner has failed to present "evidence" which would establish a prima facie case of anticipation under §102. Consequently, it is sufficient for Applicants to point out that the Examiner has failed to carry the burden imposed by §102, and Applicants are not required to also present "evidence" to rebut something on which the Examiner has failed to present relevant evidence. (Moreover, as a practical matter, there is no "evidence" which Applicants could possibly present in order to show that this feature is missing from the references. Stated differently, Applicants are not required to achieve the impossible by trying to prove a negative).

With this in mind, it is respectfully submitted that the assertion made by the Examiner in paragraph 5 of the Advisory Action is directly contrary to the language and intent of the U.S. patent laws implemented by Congress, including 35 U.S.C. §102. Consequently, paragraph 5 fails to provide any support for the Examiner's assertion that Applicants' arguments do not place the present application in condition for allowance. It is respectfully submitted that Applicant's arguments do in fact clearly distinguish the

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pending claims from the prior art relied on by the Examiner,
and the claims are thus believed to be allowable.

Respectfully submitted,
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Date: October 16, 2002

Enclosures: None

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